

## **REMARKS**

### **I. Introduction**

In response to the pending Office Action, Applicants have cancelled claim 31, amended claims 1, 20, 23, 25 and 27, and added new claims 32-35. Support for the amendment to claims 1, 20, 25 and 27, can be found, for example, in Figs. 1, 7, 11, 14 and 15 and the corresponding portions of the specification. Support for new claims 32-35 can be found in Figs. 4 and 8, and in the corresponding portions of the specification. No new matter has been added.

For the reasons set forth below, it is respectfully submitted that all pending claims are patentable over the cited prior art.

### **II. The Rejection Of The Claims Under 35 U.S.C. § 112**

Claim 31, which has been cancelled, was rejected under 35 U.S.C. § 112, first paragraph. New claim 32 recites in-part the subject matter that previously recited in cancelled claim 31. Specifically, new claim 32 recites in-part that the first laminate 13 has an upper surface which fully covers the plurality of sheet materials formed beneath the upper surface such that none of the plurality of sheet materials formed beneath the upper surface are exposed via the upper surface of the first laminate. In other words, when taking a top-down view of the first laminate 13, the sheets beneath the top layer are not exposed. It is respectfully submitted that support for this element can clearly be found in Fig. 8 and the corresponding portion of the specification, which illustrates the top surface of the first laminate, and as shown therein, no underlying sheets are exposed. Moreover, Fig. 4 shows a resulting structure formed by the present invention and as

shown therein, the upper surface fully covers underlying layers as there are no openings in the upper layer.

For the foregoing reasons, it is respectfully submitted that new claims 32-35 are fully supported by the originally filed specification.

### **III. The Rejection Of The Claims Under 35 U.S.C. § 103**

Claims 1-11, 13, 16-19 and 25-31 were rejected under 35 U.S.C. § 103 as being unpatentable over USP NO. 5,573,622 to Hass in view of USP No. 5,573,622 to Pieterse, and GB 2274810 to Koderä, and optionally in view of USP No. 5,478,420 to Gauci. Claim 12 was rejected utilizing the same prior art and further in view of USP No. 5,759,320. Finally, claims 20, 23 and 24 were rejected Hass and Koderä. For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

First, as recited by amended claim 1, the present invention relates to a novel method of manufacturing a laminate and recites that the first laminate contains polyolefin, and (in the second step) applying a pressing force to the first laminate while heating the first laminate to a temperature higher than the softening temperature of polyolefin. Furthermore, as recited by amended claim 1, when the elastic body is in contact with an upper surface of the first laminate, the elastic body has a concave shape relative to the upper surface of the first laminate.

As explained in detail in the specification, for example, on page 11, lines 19-28, although the device being formed has internal electrodes, which can result in variations in the pressure applied to the upper surface of the first laminate due to the presence or

absence of the electrodes at a given location within the device, the elastic body prevents such pressing force fluctuations, by allowing uniform pressure to be applied to the upper surface of the first laminate regardless of the presence or absence of the internal electrodes. As a result, the present invention allows the first laminate to be obtained with a narrow range of density variation.

As noted above, claim 1 has been amended to recite that the elastic body has a substantially concave shape relative to the upper surface of the first laminate when pressed in contact with the first laminate. For example, as shown in Fig. 1, the elastic member engages the planar top surface of the first laminate and extends downwardly over the side surface of the first laminate when pressed in contact therewith, so as to exhibit a substantially concave shape relative to the upper surface of the first laminate.

Turning to the cited prior art references, Hass and Gauci are the only cited references that appear to utilize an elastic pressing member. However, neither of these references disclose an elastic member which exhibits a substantially concave shape when pressed in contact with the ceramic substrates of the device being formed. Indeed, in both Hass and Gauci, the elastic member takes on a convex shape, as the upper surface of the device being formed in Hass and Gauci do not fully cover the underlying sheet layers. For example, as shown in Figs. 1 and 2 of Hass and Fig. 5 of Gauci, the elastic member extends downwardly into the middle of the device so as to contact multiple layers of the sheets forming the device. As such, in both Hass and Gauci, in contrast to the claimed invention, the elastic member has a convex shape relative to the upper surface of the laminate member. Thus, at a minimum, neither Hass nor Gauci disclose this limitation recited by amended claim 1. Moreover, none of

the other cited prior art references appear to cure the deficiencies of Hass and Gauci.

Accordingly, as each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness (see, M.P.E.P. § 2143.03), and both Hass and Gauci and the other cited prior art, at a minimum, fail to disclose the foregoing limitation, it is clear that amended claim 1 and the claims dependent thereon are patentable over the cited prior art.

For all of the foregoing reasons, it is respectfully submitted that claim 1 and all claims dependent thereon are patentable over the cited prior art.

Claims 20, 25 and 27 have been amended in a manner to similar to claim 1. It is respectfully submitted that claims 20, 25 and 27 and the claims dependent thereon are patentable over the prior art for at least the same reasons as claim 1.

#### **IV. New Claims 32-35**

New claim 32 is substantially similar to claim 1 prior to the foregoing amendment, with the exception that new claim 32 recites that the first laminate has an upper surface which fully covers the plurality of sheet materials formed beneath the upper surface such that none of the plurality of sheet materials formed beneath the upper surface are exposed via the upper surface of the first laminate.

From the discussion set forth above in Section III, it is clear that Hass and Gauci also fail to disclose this limitation. The apparent reason for the use of the elastic member of Hass and Gauci is to allow the elastic member to extend downwardly into the openings formed in the various layers of the laminate structure as shown in Fig. 2 of Hass and Fig. 5 of Gauci. Thus, it would appear that in the event that the upper surface of the

laminate of Hass or Gauci fully covered the lower layers, there would be no reason to utilize the elastic member disclosed therein. Indeed, neither Hass nor Gauci appear to even acknowledge the problem solved by the present invention (i.e., application of uniform pressure to a planar upper surface of a device having internal electrodes which cause variations in the thickness of the device).

The Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that the Hass can be modified by the Gauci patent, or any of the other references, it is submitted that the "mere fact that [the patents] can be combined ... does not render the resultant combination obvious" because nowhere does the prior art "suggest the desirability of the combination" recited by claim 32. Indeed, as noted above, in the event that the upper surface of the laminate fully covers the underlying layers, there is no need or motivation to utilize the elastic pressing members of Hass and Gauci.

The Examiner is further directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon

teach that all aspects of the claimed invention were *individually* known in the art is **not** sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, even assuming *arguendo* that the combination of the patents "teach that all aspects of the claimed invention [are] individually known in the art", it is submitted that such a conclusion "is not sufficient to establish a *prima facie* case of obviousness" because there is no **objective** reason on the record to combine the teachings of the cited prior art.

As such, it is respectfully submitted that new claims 32-35 are patentable over the cited prior art references.

#### V. Request For Notice Of Allowance

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

Date: 3/8/04

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